

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUXOTTICA OF AMERICA INC. AND META PLATFORMS, INC.,
Petitioner,

v.

SOLOS TECHNOLOGY LIMITED,
Patent Owner.

Case IPR2026-00376
Patent 12,216,339

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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All emphasis in quotations is added unless otherwise stated.

I. INTRODUCTION

Institution should be discretionarily denied. Petitioners' IPR campaign seeks to preserve advantages that the Director's institution policies are designed to prevent. Petitioners, defendants in a district court litigation asserting five patents, commenced their IPR campaign by challenging the '339 patent, the most recently issued of the five. They still have not challenged the two oldest patents—issued more than six and seven years ago—for which settled expectations are strongest. The strategy behind that sequencing is evident: challenge the newer patents with weaker settled expectations first, and then invoke those proceedings to support institution of later challenges to the older patents notwithstanding their stronger settled expectations. The Office should not reward strategic delay in challenging older patents in contravention of its settled-expectations policy. *See* Section II.A.1.

Petitioners likewise seek institution without committing to maintain in district court the claim-scope positions they advance in their IPRs. Petitioners have filed three IPR petitions challenging asserted claims, and in none do they identify a single term requiring express construction. Yet Petitioners have not committed to maintaining that position—or to forgoing indefiniteness—in the district court litigation. The Director's recent precedential and informative decisions prohibit petitioners from obtaining the advantages of inconsistent claim-scope positions across forums. If Petitioners' no-express-construction position is genuine, they

should stipulate to maintain it and forgo indefiniteness in district court. If Petitioners will not do so, institution should be denied. *See* Section II.A.2.

The Petition provides an independent reason for denial. The challenged claims require first data from a sensor in an eyewear device and second data from an external sensor to be used together in determining a “context” and, where recited, analyzing a “state.” The Examiner identified these exact relationships as bases for allowance. Yet, under Petitioners’ mappings, the asserted references do not supply them. Petitioners instead rely on their expert to select sensor sources and supply their joint use, contrary to the Office’s July 2025 Memorandum. *See* Section II.B.

Finally, the burden of an instituted proceeding is disproportionate to anything this IPR could accomplish. Petitioners ask the Board to adjudicate eight grounds against sixteen claims, each of which depends on the extensive expert-driven theories described above, while this proceeding can remove at most one patent from a five-patent district court case. The weakness of the challenge, the structure of Petitioners’ broader IPR campaign, and the substantial resources required for such limited litigation simplification all strongly favor denial. *See* Section II.C.

II. INSTITUTION SHOULD BE DISCRETIONARILY DENIED.

A. Petitioners’ Staggered IPR Strategy Undermines The Office’s Settled Expectations Doctrine And Policy Against Inconsistent Claim Constructions.

Petitioners’ IPR campaign should be considered as a whole. Petitioners have

elected to challenge the newest patents-in-suit first while postponing challenges to the two oldest patents for which settled expectations are strongest. The Office should not reward that sequencing by allowing Petitioners to build a collection of IPR proceedings against newer patents that they may later invoke to support institution against older patents whose settled expectations have only grown stronger during the delay. This would create a perverse incentive for petitioners to postpone challenges to older patents rather than bring them promptly. *See* Section II.A.1 *infra*.

Petitioners are also attempting to preserve flexibility with respect to claim construction in district court. In the instant Petition, Petitioners maintain that no express claim construction is necessary and do not indicate that any claim terms could be indefinite. Yet Petitioners have not committed to those positions in district court. If Petitioners wish to obtain institution on that basis, they should stipulate that they will maintain their no-express-construction position and not argue indefiniteness in district court. Otherwise, institution should be denied rather than permit Petitioners to obtain IPR review now while preserving different claim-scope positions for later. *See* Section II.A.2 *infra*.

1. Petitioners Cannot Erode Settled Expectations By Challenging Newer Patents First.

The Office considers the parties' "settled expectations," including "the length of time the claims have been in force." Ex. 2004 [Process Memorandum] 2. There

is no bright-line rule, but “the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, 3 (June 18, 2025) (informative) (analogizing to the six-year standard under 35 U.S.C. § 286). “Strong settled expectations” have been consistently found for patents that had been in force for seven and six years, but not (on that record) for one that had been in force for three years. *See Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9, 2–3 (July 24, 2025) (informative); *see also* Ex. 2006 [Settled Expectations Chart] (showing dozens of decisions denying institution on account of settled expectations as to patents issued six or more years ago).

Petitioners’ filing sequence is therefore significant. In the same district court complaint, Patent Owner asserted five patents against the same accused products. Ex. 2001 [Complaint] ¶¶ 43–47. Petitioners first challenged the newest patent—the ’339 patent in this IPR, which issued in February 2025—and later filed petitions against Patent Owner’s patents 11,082,055 and 11,871,174. *See generally Meta Platforms, Inc. v. Solos Tech. Ltd.*, IPR2026-00412, Paper 4 (filed Aug. 7, 2026); IPR2026-00420, Paper 1 (filed Aug. 7, 2026); IPR2026-00413, Paper 3 (filed Aug. 14, 2026). Yet Petitioners have not challenged the two oldest patents-in-suit: U.S. Patents Nos. 10,306,389, issued May 28, 2019, and 10,651,866, issued May 12, 2020. Ex. 2001 [Complaint] ¶¶ 43–44. These patents have now been in force for

more than seven and six years, respectively—the periods numerous decisions have found sufficient to create strong settled expectations. *See* Ex. 2006.

Nothing required Petitioners’ sequencing. All five patents were asserted from the outset. Petitioners knew of all five patents, but chose to challenge the newer patents first, while delaying challenges to the patents carrying the strongest settled expectations. This choice cannot diminish the settled expectations associated with the older patents—and should not advantage Petitioners at the discretionary denial stage if they later challenge them. Otherwise, petitioners accused of infringing multiple patents could postpone challenges to older patents-in-suit, build a collection of instituted proceedings against newer patents, and then invoke those proceedings as a reason why the institution of later challenges would be an efficient use of resources. This outcome would reward the same delay in filing IPR petitions that should strengthen settled expectations under *Dabico* and *Amgen*.

The Director’s recent precedential guidance confirms that discretionary denial analysis should not examine each petition in isolation, but should consider how the IPR process is being used. *Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17, 2–8 (May 14, 2026) (precedential), for example, explains that discretion in institution serves “fairness, efficiency, and predictability” and guards against use of AIA review for litigation leverage rather than as an alternative means of resolving patentability disputes. Although Petitioners were entitled to select

which patents to challenge, they should not receive an advantage from postponing challenges to patents for which settled expectations are strongest. This consideration weighs in favor of discretionary denial.

2. Petitioners Should Stipulate To Their No-Claim-Construction Position And Forgo Indefiniteness In District Court.

The Director has made clear that an IPR petitioner may not pursue unexplained, inconsistent positions about claim scope before the Board and district court. *See, e.g., Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20, 3–5 (Nov. 3, 2025) (precedential); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18, 3–4 (Nov. 5, 2025) (informative); *Terumo BCT Inc. v. Haemonetics Corp.*, IPR2025-01374, Paper 20, 3–5 (May 12, 2026) (informative). This rule applies both to offering differing claim constructions across forums, and to asserting no construction is necessary before the Board while asserting indefiniteness in district court. *See Tesla*, 3–4; *see also Terumo*, 3–5.

Petitioners have filed three IPR petitions challenging claims asserted in the

district court.¹ In all three, Petitioners identify no term requiring construction and identify no indefiniteness issues. Pet., 7; IPR2026-00412, Paper 4, 11; IPR2026-00413, Paper 3, 12–13. Yet Petitioners have not committed to maintaining those positions in district court. And it strains credulity that, across three asserted patents, Petitioners actually intend to contend that no challenged term requires construction and that no challenged claim is indefinite.

Patent Owner does not yet know Petitioners’ district court positions because claim construction has not begun. Only Petitioners know whether they intend to maintain those positions. But the Office need not institute first and find out later. If Petitioners seek institution on the position that no express construction of any term of the ’339 patent is necessary, they should stipulate that they will not argue otherwise in district court and will not assert indefiniteness there. If Petitioners will

¹ In a fourth IPR, IPR2026-00420, Petitioners challenge unasserted claims of the ’055 patent—and propose constructions, but only of means-plus-function limitations. *See* IPR2026-00420, Paper 1, 5–9 (proposing constructions of six terms in claim 46 of the ’055 patent); Ex. 2003 [Complaint-Ex. 9] (identifying asserted claims 1, 5, 7, and 10 of the ’055 patent); Ex. 2002 [Complaint-Ex. 7] (stating that “Plaintiff does not presently contend that any asserted claim limitation is governed by 35 U.S.C. § 112(f)”).

not make that commitment, the Petition should be denied.

B. The Petition’s Reliance On Expert Testimony To Supply A Limitation That Was A Basis For Allowance Warrants Denial.

All eight grounds rely on expert testimony to supply a requirement common to every challenged claim: using data from an eyewear-incorporated sensor and an external sensor together to determine the user’s context and, where recited, analyze the user’s state. The Examiner identified that relationship as a basis for allowance. *See* Section II.B.1 *infra*. Under Petitioners’ mappings, the asserted patents and printed publications do not disclose it, so Petitioners’ expert selects the sensor sources and supplies their joint use.

The Office’s recent guidance identifies precisely why Petitioners’ expert gap-filling approach warrants denial. The March 26, 2025 Memorandum re. Interim Processes for PTAB Workload Management (“Process Memorandum”) expressly identifies both “[t]he strength of the unpatentability challenge” and “[t]he extent of the petition’s reliance on expert testimony” as considerations bearing on the Director’s discretion to institute. Ex. 2004 [Process Memorandum] 2. The Director’s decisions in *iRhythm* and *Cambridge Industries* sharpen the relevant inquiry: whether a declaration merely explains the art or instead “fill[s] gaps in the prior art.” *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10, 2–3 (June 6, 2025); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*,

IPR2025-00434, Paper 11, 2 (June 26, 2025). In *Cambridge*, the patent owner failed to identify testimony that performed such gap filling; here, the Petition's own fallback language and cited declaration paragraphs identify it.

The Office's July 31, 2025 memorandum ("July 2025 Memorandum") separately directs enforcement of Rule 42.104(b)(4), which requires a petition to specify where each claim element appears in the asserted patents or printed publications. Ex. 2005 [July 2025 Memorandum] 1; 37 C.F.R. § 42.104(b)(4). Expert testimony and "common sense" may support a motivation to combine, establish a POSITA's knowledge, or explain a reference, but they "may not be used to supply a missing claim limitation." Ex. 2005 [July 2025 Memorandum] 1–2. The Board "shall deny" a petition that does not comply. *Id.*, 1. The Petition crosses that line throughout its eight grounds, as explained below. *See* Sections II.B.2–3 *infra*.

1. Joint Use Of Data From An Eyewear Sensor And An External Sensor Was A Basis For Allowance.

Every challenged claim requires receiving "first data" from a sensor "incorporated into the eyewear device," receiving "second data" from an "external sensor," and using both data sets to determine the user's "context." Claim 1 additionally requires using both data sets to analyze the user's "state," as do claims 2–5, which depend from claim 1. Ex. 1001 ['339 Patent] 32:5–27. Independent claim 11 recites the same joint-use requirements for both determining context and

analyzing state, and claims 12–16 depend from claim 11. *Id.*, 32:50–33:30. Independent claim 6 requires using both data sets to determine context, and claims 7–10 depend from claim 6. *Id.*, 32:28–49.

The Examiner expressly identified these joint-use limitations in allowing the claims. For claim 1, the Examiner explained that the prior art did not disclose or suggest receiving data from an external sensor and using “the first data and the second data” to analyze state and determine context. Ex. 1002 [Prosecution History] 34. The Examiner gave materially parallel reasons for the other independent claims. *Id.*, 35.

The specification likewise distinguishes sensors embedded in eyewear from external sensors. Figure 17 identifies external shirt-button, belt-pressure, and ingestible sensors, and Figure 24 separately depicts a communicating “local sensor 2412.” Ex. 1001 [’339 Patent] 21:23–35, 28:16–28. The claims therefore require more than multiple sensors: data from two locations must be used together in the recited context determination and, where required, state analysis.

2. Petitioners’ Asukai And Liu Grounds Impermissibly Rely On Expert Testimony To Supply The Claimed Joint Use.

Under Petitioners’ mappings, Asukai and Liu identify multiple sensors but not the claimed joint use. Petitioners reach the claimed joint use by selecting an eyewear sensor and an external sensor, then relying on their expert to explain why their data

would be used together in the recited operations. The July 2025 Memorandum permits an expert to explain a reference, not to supply a missing limitation. Ex. 2005 [July 2025 Memorandum] 1–2.

Petitioners’ Asukai theory illustrates the problem. Asukai discloses a range of sensor types and locations. The Petition relies on Asukai’s statement that its sensors may reside in information processing device 10 or in a connected wearable or smartphone, and on its disclosure that situation recognition may use external sensor data “in addition to” data from sensor unit 122. Pet., 13–19 (citing Ex. 1005 [Asukai] ¶¶ 69, 81, 93, 95–97, 103). It also relies on Asukai’s identification unit 103, which identifies emotion from recognized situation and action. Pet., 18–19 (citing Ex. 1005 [Asukai] ¶¶ 84–85).

Those disclosures identify available inputs and a processing sequence, but neither assign the data Petitioners identify as the claimed first and second data to the required sensor locations nor disclose their joint use in each recited operation. The expert supplies those steps. The Petition acknowledges that its source assignment is not stated in each example in Asukai:

To the extent a particular Asukai example does not repeat that the sensor is incorporated into the spectacle-type HMD,² that implementation would have been obvious.

Pet., 14 (citing Ex. 1003 [Feland-Decl.] ¶ 92). The expert thus moves from Asukai’s general placement options to the particular eyewear sensors used in Petitioners’ examples. *Id.*, 14–15 (citing Ex. 1003 [Feland-Decl.] ¶¶ 92–93).

The Petition also acknowledges the joint-use issue for state analysis:

To the extent PO argues that an embodiment does not expressly state that emotion analysis uses both eyewear-sensor and external-sensor data, that implementation would have been obvious because their joint use was a predictable use of complementary, known sensor inputs that would improve confidence and reduce ambiguity.

Pet., 19 (citing Ex. 1003 [Feland-Decl.] ¶¶ 101–103; Ex. 1009 [Tanaka] ¶¶ 12, 45–46). The cited Asukai passages do not disclose Petitioners’ joint use; the expert proposes both the limitation and a reason to add it.

Petitioners’ commuting example similarly assigns acceleration data to an eyewear sensor and location data to an external sensor, relying on their expert “[t]o the extent PO disputes that placement.” Pet., 20 (citing Ex. 1005 [Asukai] ¶¶ 115–

² Asukai uses “HMD” as an abbreviation for “head mounted display.” Ex. 1005 [Asukai] ¶ 68.

116; Ex. 1003 [Feland-Decl.] ¶ 106). Petitioners' parenting example repeats the joint-use gap. Asukai lists room-camera video, smart-band pulse rate, and voice data from a room microphone "or" an HMD microphone as potential inputs, but does not use Petitioners' selected HMD microphone data with external data in a single emotion analysis. Petitioners' expert supplies that combination because the inputs allegedly concern "the same parenting episode." Pet., 20–21 (citing Ex. 1005 [Asukai] ¶¶ 196–197; Ex. 1003 [Feland-Decl.] ¶ 108).

For "determining a context of the user," the Petition again relies on Asukai's statement that situation recognition may use external-sensor data "in addition to" sensor-unit data. Pet., 21–22 (citing Ex. 1005 [Asukai] ¶¶ 79, 81, 84). But the Petition conditions its mapping on "where sensor-unit data includes first data from the eyewear-incorporated sensor and external-sensor data includes second data," and then adds a fallback "[t]o the extent PO disputes that an example uses that pairing." Pet., 22 (citing Ex. 1003 [Feland-Decl.] ¶¶ 110–112). The conditional phrasing confirms that Asukai does not itself make Petitioners' claim-specific source pairing.

Petitioners' Liu grounds present the same problem. Liu discloses smart eyewear and a "terminal 130" with overlapping sensors. The devices communicate, and terminal 130 may "share the burden of collecting, storing, and/or processing data." Ex. 1006 [Liu] ¶ 23. Liu also discloses an emergency analysis that may consider physiological condition, movement, position, and images. Ex. 1006 [Liu]

¶¶ 50, 61. These passages disclose sensors and processing capability, but not the joint use of eyewear-derived and terminal-derived data in Petitioners’ mapped operation.

The Petition nevertheless states that Liu “discloses analyzing the user’s state using first data from eyewear sensors together with second data from terminal 130’s external sensors.” Pet., 51 (citing Ex. 1003 [Feland-Decl.] ¶ 201). The cited Liu passages do not state that conclusion. *Id.*, 50–51 (citing Ex. 1006 [Liu] ¶¶ 17, 21–23, 30, 50, 61). The Petition therefore offers a fallback:

To the extent PO argues Liu does not expressly state that eyewear- and terminal-sensor data are jointly used in the same state analysis, doing so would have been obvious.

Pet., 51 (citing Ex. 1003 [Feland-Decl.] ¶ 202). Petitioners’ expert then supplies both the desired configuration and its asserted rationale: data from the different devices allegedly provide complementary perspectives, improve “accuracy, reliability, and completeness,” and reduce ambiguity from “missing or noisy single-device measurements.” Pet., 51–52 (citing Ex. 1003 [Feland-Decl.] ¶¶ 202–204). Liu supplies the devices; the declaration supplies their joint use in the claimed “analyzing” operation.

The Petition’s analysis of how Liu supposedly teaches the claimed “determining” operation follows the same pattern: it infers joint use from Liu’s

sensors, communications, and shared processing, and then offers another fallback:

To the extent PO argues Liu does not expressly state that eyewear- and terminal-sensor data are jointly used in the same context determination, using them together would have been obvious.

Pet., 54 (citing Ex. 1003 [Feland-Decl.] ¶ 212). Petitioners’ expert then proposes evaluating eyewear movement or orientation data with terminal position, image, or environmental data to improve accuracy and reduce ambiguity. Pet., 54–55 (citing Ex. 1003 [Feland-Decl.] ¶¶ 212–214). Thus, Liu supplies the inputs and hardware; the declaration supplies their claim-specific joint use.

Petitioners’ Asukai- and Liu-based theories reach the same missing claim limitations by different routes, but the asserted references do not disclose the claimed relationships; Petitioners’ expert does. That is precisely what the July 2025 Memorandum prohibits, and the Petition therefore fails to satisfy Rule 42.104(b)(4)’s requirement that it identify where each claim element is found in the asserted patents or printed publications.

3. Petitioners’ Additional References Do Not Cure The Gap-Filling Dependence On Expert Testimony.

Petitioners’ additional citations and arguments do not cure the deficiencies identified above.

As one example, Petitioners cite the same three paragraphs of Petitioners’ Exhibit 1009 (“Tanaka”) in an attempt to corroborate the inferences that Petitioners

seek to draw from Asukai and Liu. For Asukai, the Petition cites Tanaka precisely where it presents its fallback obviousness theories for the claimed joint use. Petitioners invoke Tanaka to support their expert's assertion that combining eyewear-sensor and external-sensor data would improve "confidence" and reduce "ambiguity." Pet., 19, 22 (citing Ex. 1009 [Tanaka] ¶¶ 12, 45–46). For Liu, Petitioners invoke the same passages to support asserted improvements in "accuracy, reliability, and completeness." Pet., 52, 55 (citing Ex. 1009 [Tanaka] ¶¶ 12, 45–46). But Tanaka is not identified as part of any asserted ground. Pet., 9. Petitioners therefore cannot use Tanaka as an unasserted reference to supply a claim limitation absent from Asukai or Liu. At most, Tanaka can support the rationale Petitioners' expert offers for adding the missing joint use.

The cited passages do not identify Petitioners' pairings or their use in the claimed operations. Tanaka's paragraph 12 says redundant data may help "in some settings"; its paragraphs 45–46 merely identify platforms with integrated or external sensors. Ex. 1009 [Tanaka] ¶¶ 12, 45–46. In portions of Tanaka not cited by Petitioners, moreover, Tanaka emphasizes that more sensing is not invariably better. Tanaka warns that redundant sensing can cause "very inefficient management" of sensing and computing resources, "sub-optimal power consumption," reduced battery life, and increased network load. *Id.*, ¶¶ 8–11. Tanaka's own approach to these issues identifies redundancies, compares performance, selects sensors, and

shuts down unnecessary sources; it even recognizes cases in which “a single reading from any one of them would provide enough sensor data.” *Id.*, ¶¶ 8, 17–20, 52, 58–60. In particular, Tanaka does not establish Petitioners’ expert’s conclusion that particular inputs from selected devices in Asukai or Liu should be combined together in performing what Petitioners identify as the claimed operations. *Cf.* Ex. 1003 [Feland-Decl.] ¶¶ 101, 111, 202, 212.

Petitioners’ Shan reference does even less to address the deficiency. Grounds 2 and 4 add Shan for the separate requirement of a “voice interface to receive user commands.” Pet., 41–43, 63–66. Petitioners rely on Shan’s microphone for a wearer’s “spoken instruction” and its disclosure of “audio commands” for that limitation. *See id.*, 41–43, 64–65 (citing Ex. 1007 [Shan] ¶¶ 37, 41, 51). Petitioners do not rely on Shan to supply the required joint use of eyewear-sensor and external-sensor data. Grounds 2 and 4 simply carry forward the same Asukai- and Liu-based mappings addressed above. Adding Shan therefore does nothing to eliminate Petitioners’ dependence on their expert.

Petitioners’ Lisy Grounds 5–8 may be the most revealing, because Petitioners add Lisy specifically to bolster the disputed joint use:

Grounds 5–8 provide an additional obviousness basis to the extent PO disputes the joint use of sensor-derived data for the claimed state analysis and context determination, including the use of eyewear-

sensor first data with external-sensor second data and, for claim 16, the use of first data with third data from a plurality of embedded sensors.

Pet., 75. Unlike Shan, Lisy is at least generally directed to the gaps Petitioners' own analysis identifies in Asukai and Liu. But Lisy's role is still general: it supplies a "fusion" concept without the claim-specific selection and application of Asukai's or Liu's data. This does not cure the deficiency. The cited disclosures say only that data from sensors on different devices may be "fuse[d]" to provide a "more complete and robust set of data," recommendations, and warnings. Ex. 1008 [Lisy] 4:2–9. But Grounds 5–8 require much more: Petitioners must establish that data from an eyewear sensor and an external sensor would be used together in the particular state analysis and context determination mapped from Asukai or Liu. Petitioners again turn to their expert to select the relevant Asukai or Liu sensor inputs and argue that Lisy's general "fusion" teaching would be applied to those inputs in the claimed operations.

The Petition confirms that the expert—not Lisy—supplies the missing claim-specific application. For the Asukai-Lisy grounds, Petitioners argue that a POSITA would have applied Lisy's fusion approach to "jointly us[e] complementary sensor inputs" in Asukai's "situation/action recognition, emotion/state analysis, context determination, and feedback selection." Pet., 76–77 (citing Ex. 1003 [Feland-Decl.] ¶¶ 280–284). But neither reference identifies which Asukai sensor data should

constitute the claimed first and second data or teaches using those particular data together in the claimed state analysis and context determination. Petitioners' expert supplies those steps by selecting the relevant Asukai inputs and concluding that applying Lisy's general fusion teaching to them would "predictably enhance[]" Asukai's operations. *Id.*, 76–77 (citing Ex. 1003 [Feland-Decl.] ¶¶ 283–284).

Petitioners' Liu-Lisy grounds follow the same pattern. The expert proposes adding Lisy's fusion "so that the eyewear-sensor data and external-sensor data were jointly used in analyzing user state and determining context." Ex. 1003 [Feland-Decl.] ¶ 287; *see* Pet., 78–79. That is the claim-required relationship—and it comes from the declaration, not Liu or Lisy. Grounds 5–8 therefore remain expert-driven.

C. Institution Would Be An Inefficient Use Of The Board's Resources.

Institution would require substantial Board resources but would have minimal impact on the parallel district court litigation. The district court action asserts five patents against the same accused products. *See* Ex. 2001 [Complaint] ¶¶ 5, 43–47. This proceeding alone could remove, at most, one patent from the five-patent case. The Office has denied institution where litigation involving other asserted patents would continue notwithstanding the IPR, reasoning that Board review under those circumstances "would be an inefficient use of Board resources." *Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00768, Paper 15, 3 (Aug. 14, 2025); *see also*

Samsung Elecs. Co. v. iCashe, Inc., IPR2025-00641, Paper 12, 3 (Aug. 14, 2025).

That limited potential benefit stands in stark contrast to the resources institution would require. The Petition presents eight grounds challenging sixteen claims. Claims 1–10 face four grounds each, while claims 11–16 face six grounds each. Pet., 9. The Board may consider whether the number of claims and grounds warranting review makes institution an efficient use of its resources. *Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9, 10–11 (Nov. 7, 2018) (informative). Here, institution would require the Board to adjudicate eight overlapping grounds—many involving multiple references and the heavily expert-dependent theories discussed above—to remove, at most, one patent from litigation. That disproportionate expenditure of Board resources strongly favors denial.

III. CONCLUSION

For these reasons, Patent Owner respectfully requests that institution be denied under 35 U.S.C. § 314(a).

Respectfully submitted,

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Date: August 24, 2026

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served
by electronic service, by agreement between the parties, on the date below:

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

EXHIBITS 2001-2006

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Respectfully submitted,

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